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Application Number	10672,133
Filing Date	9/26/03
First Named Inventor	Stephen Ewald
Art Unit	3625
Examiner Name	J. Smith
Attorney Docket Number	49663.21740

ENCLOSURES (Check all that apply)

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Firm Name	Carlton Fields, P. A.		
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Printed name	Lance D. Reich		
Date	7/14/05	Reg. No.	42,097

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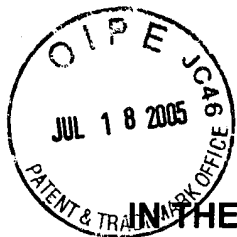
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	EWALD	:	Group Art Unit:	3625
Serial No.	10/672,133	:	Examiner:	Smith, J.
Filed:	09/26/2003	:	Confirmation No.	6111
For:	SYSTEM AND METHOD FOR PURCHASING LINKED WITH BROADCAST MEDIA	:	Attorney Docket No.	49663.21740

APPEAL BRIEF

Mail Stop Appeal Brief-Patents
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Sir:

Pursuant to 37 C.F.R. §1.192, Applicant submits this Appeal Brief in the present application.

REAL PARTY IN INTEREST

The real party in interest in the application and Appeal is Stephen A. Ewald, a US citizen having a residence at 10204 Rubury Place, Tampa, FL, 33626 USA.

RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences known to Appellant which may be related to, directly affect or be directly affected by, or have a bearing on the Board's decision in this Appeal.

STATUS OF CLAIMS

Claims 1-19 are pending in the appeal. Claims 1-19 are finally rejected.

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STATUS OF AMENDMENTS

No amendment has been filed since the final rejection of this application.

SUMMARY OF CLAIMED SUBJECT MATTER

Independent Claims 1, 9, and 12 are directed to a system, method and apparatus for purchasing goods and services advertised in broadcast media. In particular, all of the claims include the element of a broadcast receiver 14 that receives a “purchase request” from a person desiring to purchase a good or service advertised in the broadcast media. In essence, once the purchase process is started at the broadcast receiver 14, such as by pressing a button 15, the purchase will be completed either instantaneously, such as through a direct communication to the server 32, (Para. [0019]) or through a delayed process insofar as purchase data is transmitted once communication with the server 32 can be established (Para. No. [0020]). While one or more steps can comprise the purchase process at the broadcast receiver 14 beyond a mere button 15 press, the purchase process is fully started at the broadcast receiver and will be fulfilled provided that the verification by the server 32 can be done, i.e. account information is correct, media is available for purchase, etc.

Claim 1, as shown in Fig. 1, is for “a system [10] for purchasing goods and services linked with broadcast media comprising one or more broadcast receivers [14] that receive a broadcast media including information relating to goods and services that can be purchased by persons receiving the media, each receiver [14] further selectively receiving a purchase request and recording the purchase data for goods and services that a person purchases relating to the broadcast media; and one or more servers [32] that selectively receive and verify purchase data sent from the one or more broadcast receivers [14].” (emphasis added)

Claim 9, as shown in Fig. 2, is for “a broadcast receiver [14] for purchasing goods and services linked with broadcast media, the broadcast receiver [14] receiving a broadcast media including information relating to goods and services that can be purchased by persons receiving the media, the broadcast receiver [14] further selectively receiving a purchase request and recording the purchase data for goods and services that a person purchases linked with the broadcast media and selectively transmitting the purchase data to another computer device.” (emphasis added). The broadcast receiver 14 specifically includes as the means for making a purchase request an indicator button 15 that is pressed by the person desiring to make a purchase.

Claim 12, as shown in Figs. 3 and 4, is directed to “a method for purchasing goods and services linked with broadcast media, comprising the steps of: receiving at a broadcast receiver [14] a broadcast media including information relating to goods and services that can be purchased by persons receiving the media; receiving at the broadcast receiver [14] a purchase request; selectively recording purchase data at the broadcast receiver [14] for a good and service that a person purchases relating to the broadcast media; sending the purchase data from the broadcast receiver [14] to at least one server [32]; receiving the purchase data at the at least one server [32]; and verifying the purchase data from the broadcast receiver [14] at the least one server [32].” (emphasis added).

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1-13, and 15-19 were rejected under 35 U.S.C. §102(e) as being anticipated by *Kesling et al.* (US Publication No. 2002/0132575 A1). The Examiner stated that *Kesling, et al.*, as including by reference US Application Serial No. 09/461,699, discloses all elements of the rejected claims. Specifically regarding the element of the “purchase request” in the rejected independent claims, the Examiner noted that *Kesling, et al.* discloses a “User interface 1000 [that] also allows the receiver to receive input from a listener/user indicating an interest in a given selection. In a preferred embodiment, the user interface includes one or more buttons that can be pressed to record, select or tag the program identifier associated with the selection of interest.” (*Kesling*, Para. [0041]) Final Office Action, p. 7. The Examiner further noted that: “If high power wireless module 700 is a transceiver, then information concerning the selected program identifiers can be sent directly back to radio 20 for almost immediate review by the listener. Thus, for example, if the listener wishes to purchase a product that has just been advertised, he can press select button 1220, and receive further information regarding the product such as price and availability. This information is preferably displayed on display 1200. The listener might even complete the transaction using radio 20, which, since it includes the high power wireless transceiver, can function as a conventional text pager.” (*Kesling*, Para. [0066]). Final Office Action, p. 7-8.

The Examiner summarized that “[i]n light of these passages it appears that *Kesling, et al.* does, indeed, disclose a ‘purchase request’ in the manner recited in the claims. However, further to the issue of what *Kesling, et al.* intends to encompass by the phrase ‘indicating an interest’ in a given selection, it is clear from the incorporated ‘699 application that such ‘interest’ includes an ‘interest in purchasing a selection’ (citing ‘699 at page 2, last line- page 3, line 2). Final Office Action, p. 7-8.

Claim 14 was rejected under 35 U.S.C. §103(a) as being unpatentable over *Kesling et al.*, in view of an Official Notice regarding secure communication channels. Final Office Action, p. 6. The Examiner noted that *Kesling, et al.*, does not disclose a secure communication channel, but that it is notoriously well-known to employ secure communication channels when endeavoring to conduct transactions of the type disclosed by *Kesling, et al.* The Examiner summarized that one of ordinary skill in the art would have modified the *Kesling, et al.*, method to have included sending purchase data via a secure channel in order that confidential information relative to the customer or the customer’s account is not readily intercepted. *Id.*

In sum, the rejection of all claims hinges on the Examiner’s interpretation of the *Kesling, et al.* reference, including the ‘699 application incorporated by reference, disclosing the element of a “purchase request” as claimed in the independent claims.

ARGUMENT

The Appellant submits that Claims 1-8 are grouped together as claiming a system including a broadcast receiver with a purchase request capability; Claims 9-11 are grouped together as claiming a broadcast receiver with a purchase request capability; and Claims 12-19 are grouped together as claiming a method of receiving and recording a purchase request at the broadcast receiver for a good and service that a person purchases relating to the broadcast media. The element of the “purchase request” being made from the broadcast receiver is neither shown nor enabled in *Kesling, et al.*, and all grounds of rejection based thereupon cannot stand.

A. Rejection of Claims 1-13 and 15-19 under 35 U.S.C. §102(e)

As defined by the Applicant, all of the claims include the element of a broadcast receiver 14 that receives a “purchase request” from a person desiring to purchase a

good or service advertised in the broadcast media, wherein once the purchase process is started at the broadcast receiver 14, such as by pressing a button 15, the purchase will be completed. Conversely, *Kesling, et al.*, involves a satellite radio broadcast system (See Abstract) with a user interface 1000 that “allows the receiver to receive input from a listener/user indicating an interest in a given selection.” Page 3, Paragraph No. [0041]. The pressing of the button selects a “program identifier” and the user receives a “media link”, which can be a physical or wireless link to more information about the program. *Kesling, et al.*, Page 4, Paragraph No. 41 and Page 5, Paragraph Nos. 64, 65. In fact, “if the program identifier identifies a particular song and artist the [linked] web site preferably provides information regarding how the listener can obtain or purchase a copy of a compact disc (CD) on which the music selection(s) can be found [.]” *Id.*, Page 4, Paragraph No. 51. Therefore, the broadcast receiver of *Kesling, et al.*, discloses at most an “informational request,” and not a “purchase request” as claimed the present invention.

The Examiner however argues that the passage: “Thus, for example, if the listener wishes to purchase a product that has just been advertised, he can press select button 1220, and receive further information regarding the product such as price and availability. This information is preferably displayed on display 1200. The listener might even complete the transaction using radio 20, which, since it includes the high power wireless transceiver, can function as a conventional text pager.” ((*Kesling*, Para. [0066])). Final Office Action, p. 7-8) (emphasis here added) somehow shows“ that *Kesling, et al.* does, indeed, disclose a “purchase request” in the manner recited in the claims.” These cited statements, however, do not rebut Appellant’s assertion that (1) the request made at the broadcast receiver is only for information, and (2) the mere statement that the “listener might even complete the transaction using radio 20,” is not sufficiently enabling to constitute a valid rejection for anticipation.

1. The Kesling Reference Does Not Expressly or Inherently Disclose a “Purchase Request”

“[A] claim is anticipated if each and every limitation is found either expressly or inherently in a single prior art reference.” *Celeritas Tech., Ltd., v. Rockwell Int’l Corp.*,

150 F.3d 1354, 1361 (Fed. Cir. 1998); MPEP §2131. Here, a “purchase request” as claimed in independent claims 1, 9, and 12 is simply not disclosed by *Kesling, et al.*

The passage from *Kesling, et al.*, relied upon by the Examiner: “if the listener wishes to purchase a product that has just been advertised, he can press select button 1220, and receive further information regarding the product such as price and availability,” does not cause the purchase of the product, and specifically states that the listener will only receive “further information.” Notwithstanding the guidance of this statement, the Examiner then points to the later statement: “The listener might even complete the transaction using radio 20” to surmise that *Kesling, et al.*, “does, indeed, disclose a ‘purchase request’ in the manner recited in the claims.” However, the term “transaction” is not defined in the specification of *Kesling, et al.*, as making a purchase.

Moreover, the immediate sentence to the term “transaction” cited by the Examiner describes the listener requesting “further information” by pressing the select button. Then the passage notes that the “transaction” can be done at the broadcast receiver because “it includes the high power wireless transceiver, [and] can function as a conventional text pager.” Therefore, the most reasonable interpretation of the term “transaction” in this passage of *Kesling, et al.*, appears to be that the transaction of the listener obtaining further information can be completed through the text messaging of the wireless transceiver. Nowhere does *Kesling, et al.*, state a purchase can be completed from the broadcast receiver.

2. The Kesling Reference Does Not Enable a “Purchase Request”

Even with an assumption that the *Kesling, et al.*, reference somehow suggests that the term “transaction” includes the completion of a purchase solely from the broadcast receiver, there is no teaching to one of skill in the art about how this would be accomplished. A patent claim “cannot be anticipated by a prior art reference if the allegedly anticipatory disclosures cited as prior art are not enabled.” *Elan Pharm., Inc. v. Mayo Found. for Med. Educ. & Research*, 346 F.3d 1051, 1054 (Fed. Cir. 2003); *PPG Industries, Inc. v. Guardian Industries Corp.*, 75 F.3d 1558, 1566, 37 USPQ2d 1618, 1624 (Fed. Cir. 1996)(The anticipating reference “must disclose every element of the challenged claim and enable one skilled in the art to make the anticipating subject matter.”) “The disclosure in an assertedly anticipating reference must provide an

enabling disclosure of the desired subject matter; mere naming or description of the subject matter is insufficient, if it cannot be produced without undue experimentation” §MPEP 2121.01,(citing *Elan Pharm.*).

Here, if the Examiner is correct in stating that the cited term “transaction” does indeed encompass completing a purchase request from the broadcast receiver, there is no enabling description on how to complete such transaction. Firstly, it should be noted that the statement cited by the Examiner is ambiguous on its face—“the listener might even complete the transaction using radio 20.” With only this speculative statement in support, there is no clear guidance from *Kesling, et al.*, that one can complete the transaction from the broadcast receiver.

Secondly, the only technical detail that is given is that the broadcast receiver “includes the high power wireless transceiver, [and] can function as a conventional text pager.” No further guidance is given to how the transaction can be done. How can this constitute an enabling disclosure to one of skill in the art? There clearly would be further experimentation necessary to create a broadcast receiver-generated purchase request in *Kesling, et al.* Accordingly, even if the Examiner is correct in interpreting a “transaction” completed at the broadcast receiver of *Kesling, et al.*, to encompass a purchase request, this is solely a mere naming or description of the subject matter which would require further undue experimentation to perform this function, and is insufficient to support the present rejection. See MPEP §2121.01.

Therefore, because *Kesling, et al.*, clearly does not disclose or enable the element of the “purchase request,” the rejection of Claims 1-13 and 15-19 as anticipated by *Kesling, et al.*, cannot stand.

B. Rejection of Claim 14 under 35 U.S.C. §103(a)

In order to render obvious Claim 14, the suggested combination must disclose all elements thereof. MPEP §2143.03; *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Claim 14 is dependent from independent Claim 12, which includes the step of the broadcast receiver receiving a purchase request, and Claim 14 accordingly includes this element. As argued above, *Kesling, et al.*, does not disclose the element of a purchase request originating at the broadcast receiver. The Appellant therefore submits that the suggested modification of *Kesling, et al.*, with an Official Notice of secure

communication protocol does not disclose this element, and the rejection of Claim 14 under 35 U.S.C. §103(a) cannot stand.

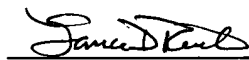
CONCLUSION

For the reasons enumerated above, the Appellant believes that the Examiner's conclusions were in error and requests that all claims be allowed.

No additional fees are believed due. However, the Commissioner is hereby authorized to charge any additional fees which may be required, including any necessary extensions of time, which are hereby requested, to Deposit Account No. 03-0683.

Respectfully submitted,

Stephen A. Ewald
By his Representatives,



Lance D. Reich
Reg. No. 42,097

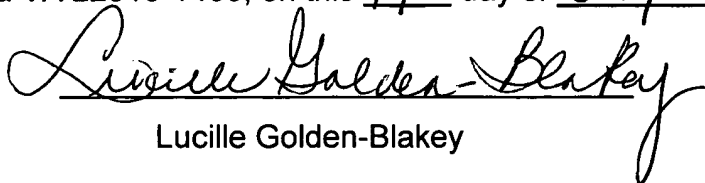
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Lucille Golden-Blakey

CLAIMS APPENDIX

1. A system for purchasing goods and services linked with broadcast media, comprising:
one or more broadcast receivers that receive a broadcast media including information relating to goods and services that can be purchased by persons receiving the media, each receiver further selectively receiving a purchase request and recording the purchase data for goods and services that a person purchases relating to the broadcast media; and
one or more servers that selectively receive and verify purchase data sent from the one or more receivers.
2. The system of claim 1, wherein each broadcast receiver is in communication with a server.
3. The system of claim 1, wherein each broadcast receiver stores the purchase data and transmit the stored purchase data at a predetermined location.
4. The system of claim 1, wherein each broadcast receiver includes a radio.
5. The system of claim 1, wherein the broadcast media includes information about the purchase of the goods and services.
6. The system of claim 1, wherein the broadcast media does not include information about the purchase of the goods and services.
7. The system of claim 1, wherein each broadcast receiver is a single device.
8. The system of claim 1, wherein each broadcast receiver is comprised of at least two devices, to include a broadcast media receiver and a purchase selection device.

9. A broadcast receiver for purchasing goods and services linked with broadcast media, the broadcast receiver receiving a broadcast media including information relating to goods and services that can be purchased by persons receiving the media, the broadcast receiver further selectively receiving a purchase request and recording the purchase data for goods and services that a person purchases linked with the broadcast media and selectively transmitting the purchase data to another computer device.

10. The broadcast receiver of claim 9, further comprising a purchase selection indicator.

11. The broadcast receiver of claim 9, wherein the broadcast receiver further stores the purchase data and transmits the stored data at a predetermined location.

12. A method for purchasing goods and services linked with broadcast media, comprising the steps of:

receiving at a broadcast receiver a broadcast media including information relating to goods and services that can be purchased by persons receiving the media;

receiving at the broadcast receiver a purchase request;

selectively recording purchase data at the broadcast receiver for a good and service that a person purchases relating to the broadcast media;

sending the purchase data from the broadcast receiver to at least one server; receiving the purchase data at the at least one server; and verifying the purchase data from the broadcast receiver at the least one server.

13. The method of claim 12, wherein:

the step of sending the purchase data is sending the purchase data to a plurality of servers; and

further comprising the step of storing the purchase data of one of the servers; and

wherein the step of verifying the purchase data occurs at a different server.

14. The method of claim 12, wherein the step of sending the purchase data is sending the purchase data from the broadcast receiver to the server via a secure communication channel.

15. The method of claim 12, further comprising the steps of:
storing the purchase data at the broadcast receiver; and
transmitting the stored data from the broadcast receiver to the server when the broadcast receiver is at a predetermined location.

16. The method of claim 12, further comprising the steps of:
storing the purchase data at the broadcast receiver; and
transmitting the stored data from the broadcast receiver to the server at a predetermined period of time.

17. The method of claim 12, wherein the step of receiving at a broadcast receiver a broadcast media receiver is receiving a radio signal at a radio receiver.

18. The method of claim 12, wherein the step of receiving at a broadcast receiver a broadcast media is receiving a broadcast media that includes information about the purchase of goods and services contained within the broadcast media.

19. The method of claim 12, wherein the step of receiving at a broadcast receiver a broadcast media is receiving a broadcast media that does not include information about the purchase of goods and services contained within the broadcast media.